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| 09/914,315      | 08/24/2001  | Jacques Sonzogni     | 98RO12954170        | 2214             |

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EXAMINER

PAIK, STEVE S

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/914,315

Applicant(s)

SONZOGNI ET AL.

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on 10 October 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

2. The corrected or substitute drawings were received on October 10, 2001. These drawings are acceptable.

### ***Response to Amendment***

3. Receipt is acknowledged of the Pre-Amendment filed on August 24, 2001.

### ***Claim Objections***

4. Claim 17 is objected to because of the following informalities: the word, "causes" in line 2 appears to be "resets". If that is not what the applicant intends to claim, the examiner respectfully requests further clarification. Appropriate correction is required.

5. Claim 33 is objected to because of the following informalities: upon careful analysis of dependency of presented claims, the examiner has found an error in claim 33. It is submitted as depending on itself. The examiner believes, after drawing a claim dependency tree, it would depend on a previous dependent claim 32. Accordingly, the claim has been examined using said dependency. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2876

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (US 4,985,921) in view of Pockrandt et al. (US 5,678,027).

Re claims 5, 8, 14, 20, 23 and 29, Schwartz discloses a portable data carrying device (chip card 1) and a method for securing access to the device comprising a microprocessor (col. 2, ll. 42-45) including an operating system working with a set of instructions, said microprocessor (2, 2a-2c in Figs. 1-4) comprising a first register (one of slots in 10 or 10a in Fig. 3 and 4) for storing a first code (microcode) and a second register (15) for storing a second code for an application program (stored in the data memory 5) when a last call instruction was sent. The chip card further comprises a memory (5) connected to said microprocessor (2, 2a-2c) for storing a plurality of application programs (data). The chip card provides a protection from unauthorized or unintended data modification by using a secure microcode signal (C).

While Schwartz teaches and fairly suggests an error checking mechanism using a special code (microcode) in a register in the field of a portable data-carrying device such as an integrated chip card, he is less explicit about a check bit included in the microcode within the register.

Pockrandt et al. discloses a method for preventing unauthorized modification of data in a portable device such as a chip card having a non-volatile memory, a central processing unit, and an error-checking device using a check bit in a check register. A check bit is set in a check register according to a command processed by a central processing unit (col. 1, ll. 61-67 and col. 2, ll. 1-15). Any data modification program takes place after the check process and a permission

given afterwards. The check process undoubtedly prevents unauthorized and unintended data modification, which results in keeping a more secured portable data storage device.

In view of foregoing teachings, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the check process, as taught by Pockrandt et al., into the chip card of Schwartz for the purpose of providing a checking device within a chip card to prevent an unauthorized or unintended data modification.

Re claims 6, 21 and 30, Swartz in view of Pockrandt et al. discloses the chip card and the method as recited in rejected claims 5, 20 and 29 stated above, where the microprocessor comprises a second register (15 in Fig. 4) for storing a second code for the application programs active when a last call instruction was sent.

Re claims 7, 15, 22 and 31, Swartz in view of Pockrandt et al. discloses the chip card and the method as recited in rejected claims 6, 14, 21 and 29 stated above, where the second register cannot be directly accessed (the registers are coordinated with the microcodes of the control unit 2a).

Re claims 9, 10, 16, 17, 24, 25, 32 and 33, Swartz in view of Pockrandt et al. discloses a barrier logic circuit (SL in Fig. 1 of Pockrandt) which resets the processing unit as a function of the status of a check register (KR).

Re claims 11, 18, 26 and 34, Swartz in view of Pockrandt et al. discloses the first register is updated in response to the return instruction (col. 3, ll. 13-17).

Re claims 12, 27 and 35, Swartz in view of Pockrandt et al. discloses the chip card and the method as recited in rejected claims 5, 20, and 29 stated above respectively, where the checking device passes a control signal based on the status of check register (KR in Fig. 1

Art Unit: 2876

communicates with CPU) for providing access to the location of the memory (NVM) if the new entity is authorized.

Re claims 13, 19, 28 and 36, Swartz in view of Pockrandt et al. discloses the chip card and the method as recited in rejected claims 5, 14, 20 and 29 stated above, where the checking device (check register) checks and grants permission to modify data at a specific location of the memory after checking the status of the check register.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Everett et al. (US 5,715,431) discloses a method of a secure data modification in a non-volatile memory of a portable data storage device.

Miyahara et al. (US 5,165,043) discloses a memory card system and a method of accessing the memory card based on the number of bytes entered in the status indicating area.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6893 for regular communications and 703-308-7722 for After Final communications.

Application/Control Number: 09/914,315

Page 6

Art Unit: 2876

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

*Steven Paik*

Steven S. Paik  
Examiner  
Art Unit 2876

ssp  
March 19, 2003



MICHAEL G. LEE  
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